

REMARKS

In response to the Advisory Action of July 30, 2008, independent claims 7 and 9 have been amended to more clearly claim Applicants' golf club head and a golf club including the head to distinguish them from the cited prior art. Reconsideration of the rejection of the claims as set forth in the Final Office Action of April 23, 2008 is therefore requested.

More particularly, claims 7 and 9 have been amended to include, in addition to the inner surface of hollow portion of the golf club head having either or both of a concave surface and a flat surface, the limitation that "an inner surface of the closed shaft insertion hole forms a continuous surface with either or both of said concave and flat surfaces and the entire inner surface of the hollow portion, including the inner surface of the closed shaft insertion hole, has no projecting portion formed thereon."

This limitation is fully supported by FIG. 5 and the description on page 15, lines 5-17 of the specification, where the inner surface of the hollow portion 52 is formed by flat and concave surfaces (54 and 56a-b) and a columnar neck member 58 having a shaft insertion hole is closed at a hollow portion side of the member. As can be seen in FIG. 5, an inner surface of the closed shaft insertion hole forms a continuous surface with inner flat surface 56a and the concave surface 54d and the entire inner surface of the hollow portion 52, including the inner surface of the closed shaft insertion hole, "has no projecting portion formed thereon." Particularly, the neck member 58 does not project into the hollow portion 52. See FIG. 5 and page 15 lines 10-11 of the specification.

The golf club head of the present invention is intended to be used with an expandable bladder 32 (see FIG. 4). As noted on page 15, lines 12-17, the probability

of defects occurring in the bladder can be reduced when a golf club head having the claimed structure is used because no protrusions or recesses exist within the hollow portion 52 which may cause defects in a freely expandable bladder.

In the above Office Action, the Examiner rejected claims 7 and 9-11 under 35 U.S.C. §103(a) for being obvious over Mackay in view of Satoh. However, it is submitted that the references together do not show the claimed structure. Moreover, what is shown in the references would not provide the advantages obtained with Applicants' structure as described above.

Mackay differs from the claimed structure in that the flat and concave surfaces making up the inner surface of the hollow portion of the club head do not have "no projecting portion formed thereon." To the contrary, FIG. 5 of Mackay clearly shows a "projecting portion" in hole 34 near rear edge 38 and to the right of insertion hole 59. See also FIG. 9 which shows a similar structure.

In addition, Mackay does not have a closed shaft insertion hole. However, the Examiner believes it would be obvious to do so in view of Satoh, which shows in FIG. 6 thereof a neck of a golf club head having a closed inner end, as explained in the Advisory Action. Nevertheless, even if, for the sake of argument, it was obvious to close off the inner end of the shaft insertion hole of Mackay in view of Satoh, it can be seen with reference to the dotted portion at the bottom of the shaft hole in FIG. 1 of Mackay, that the inner surface of the closed shaft insertion hole would not form a "continuous surface" with the other inner surfaces of the hollow portion of the golf club head and would, in effect create "a projecting portion" in the hollow portion.

Even if Satoh was further used to make the inner end of the shaft insertion hole of Mackay look exactly like Satoh's in FIG. 6, as opposed to FIG. 1 of Mackay, there would still be a portion of it "projecting" into the hollow portion. Note the sharp corner on the left side of bottom wall 11 in FIG. 6 of Satoh.

Thus the combination of references, even if combined in the manner proposed by the Examiner, would not meet the following claimed limitations:

- 1) the inner surface of the closed shaft insertion hole forms a continuous surface with either or both of said flat and concave surfaces (of the hollow portion); and
- 2) the entire inner surface of the hollow portion, including the inner surface of the closed shaft insertion hole, has no projecting portion formed thereon.

As required by MPEP § 2143.03, "all words in a claim must be considered in judging the patentability of the claim against the prior art." Moreover, as noted in MPEP § 2143.02, to support a conclusion that a claim would have been obvious," all the claimed elements" must have been known in the prior art.

Accordingly, since the claimed elements are not shown to be known in the cited prior art, it is submitted the combination of these references do not support a conclusion of obviousness. Their withdrawal as a ground of rejection under §103(a) and allowance of claims 7 and 9-11 is requested.

An RCE is being filed with this Amendment to enable the Examiner to consider the amended claims.

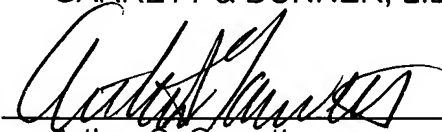
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 24, 2008

By:

A handwritten signature in dark ink, appearing to read "Arthur S. Garrett", is written over a horizontal line.

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